

REMARKS

Claims 12-15, 17-22, 24-25, 38-43, 59-63 and 66-68 stand rejected under 35 U.S.C. 112, first paragraph, for allegedly failing to comply with the enablement requirement.

The Office Action contends that the specification does not contain an enabling disclosure for the auctioning of goods or service based on at least one offer and at least one counteroffer. Applicants respectfully traverse.

The Office Action is incorrect – auctioning based on at least one offer and at least one counteroffer is enabled by the specification and claims. The standard for determining whether the specification meets the enablement requirement was cast by the Supreme Court as: “Is the experimentation needed to practice the invention undue or unreasonable?” *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916); MPEP, 2164.01, page 2100-185, Rev. 2, May 2004. “The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778 (Fed. Cir. 1988).

The specification does contain enabling disclosure for the features auction, offer and counteroffer as claimed. The specification of the present application discloses how an auction, offer and counteroffer could be used with the invention, so that experimentation to practice the invention would not be needed. The specification discloses that a “good or service may be auctioned to the customers responsive to negotiations between the reservation communication device 102 and the customers for the good or the service. The auction would include offers and counter offers between both parties in an attempt to reach an agreement. The auction would also permit the various businesses to be more aggressive with their business depending on various business factors, such as time of day, week and year, volume of activity and any given time, special promotions, etc.” Spec., page 15, lines 18-23. In addition,

the specification discloses that “[a]t step 304, the customer communication device 104 may negotiate with the reservation communication device for the good or the service desired by the customer responsive to the reservation communication device auctioning the good or the service to the customer.” Thus, with regard to auctions, offers and counteroffers, one skilled in the art could make or use the invention from the disclosure as filed and information known in the art without undue experimentation.

Moreover, the MPEP is clear that a claim “in and of itself may enable one skilled in the art to make and use the claims containing the limitation.” MPEP, 2164, pages 2100-184 through 2100-185, Rev. 2, May 2004. Claims 7, 11, 16 and 23 as filed with the present invention disclose “auctioning”. Claims 7 and 11 as filed recite “auctioning the good or the service to the customers responsive to negotiations between the reservation communication device and the customers for the good or the service.” Claims 16 and 23 recite “negotiating with the reservation communication device for the good or the service desired by the customer responsive to the reservation communication device auctioning the good or the service to the customer.”

In addition, the dictionary definitions supplied earlier by Applicants support the terms auction, offer and counteroffer as disclosed and claimed in the application. A patent need not teach, and preferably omits, what is well known in the art. See *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991). It is well known to a person of skill in the art that an auction is “a sale of property to the highest bidder” and that a counteroffer is “a return offer made by one who has rejected an offer,” as evidenced by the dictionary definitions. Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1998, page 75, a copy of which was previously provided with Amendment E. Persons in the telecommunications industry and/or auctioning industry would understand the meaning of the terms as claimed and would be enabled to make or use the invention. “When an invention, in its different aspects, involves distinct arts, that specification is

enabling if it enables those skilled in each art, to carry out the aspect proper to their specialty." MPEP, 2164.05(b), page 2100-192, Rev. 2, May 2004

The Office Action has not met the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. See *In re Wright*, 999 F.2d 1557, 1562 (Fed. Cir. 1993); MPEP, 2164.04, page 2100-189, Rev. 2, May 2004. If the Office Action wishes to maintain the rejection, the Office Action "must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure." "Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." *In re Wright*, 999 F.2d 1557 (Fed. Cir. 1993); MPEP, 2164.04, page 2100-189, Rev. 2, May 2004. For at least these reasons, Applicants respectfully request that the rejection be withdrawn.

Claims 12, 13, 18-21 and 38-42 stand rejected under 35 U.S.C. 103 as being unpatentable over Zeitman (U.S. Patent No. 5,940,481) in view of Yoshida (U.S. Patent No. 5,877,704) and Walker (U.S. Patent No. 5,794,207).

Zeitman purports to disclose a parking management communication system including a central control unit having a data base, a central interface unit and at least one user interface unit. The central interface unit is in communication with the at least one user interface unit via at least one of a wired and wireless communication link.

Yoshida purports to disclose a parking-site reservation control system. To reserve a parking site, communications is performed between an overhead road device disposed above a road and a vehicle-mounted device installed on the vehicle. See Abstract. A reservation information transmission instruction is transmitted to the vehicle-mounted device and reservation information is awaited. When the reservation information is received, reservation confirmation information is transmitted to the vehicle-mounted device and confirmation is awaited. When reservation confirmation is received, the overhead road device

petitions for a reservation to determine if the reservation is acceptable. If the reservation is acceptable, the reservation is processed. If the reservation is not accepted, however, a reservation-information transmission instruction is transmitted to the vehicle-mounted device and reservation information from the vehicle-mounted device is awaited. Col. 9, ll. 22-48.

Walker et al. purports to disclose a method and apparatus for allowing prospective buyers of goods and services to communicate a binding purchase offer globally to potential sellers. Sellers can conveniently search for relevant buyer purchase offers, and for sellers potentially to bind a buyer to a contract based on the buyer's purchase offer. A controller makes purchase offers available globally to potential sellers and potential sellers then have the option to accept a purchase offer and thus bind the corresponding buyer to a contract. Abstract. The potential seller can also make a counteroffer. Col. 9, lines 44-51. Multiple sellers may make offers to bind the buyer, with the original binding seller completing the contract only if no better offer from a seller has been received. Col. 16, 37-41.

Neither Zeitman, Yoshida nor Walker et al., alone or in combination, disclose or suggest at least "auctioning the good or the service" to the customer. The office action is correct that Zeitman nor Yoshida do not disclose or suggest auctioning the good or the service to the customer. Walker et al. fails to fill the gaps. As previously discussed, an auction is "a sale of property to the highest bidder." See, e.g., Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1998, page 75, a copy of which is attached at Appendix A. In Walker et al., other sellers may make offers to bind, Col. 16, lines 37-41, but Walker et al. does not disclose or suggest auctioning "to the customer." Therefore, there is no auction, e.g., bids from bidders and the sale to the highest bidder, disclosed or suggested in Walker et al. Since neither Yoshida, Zeitman nor Walker et al., alone or in combination, disclose or suggest at least such an auctioning, Applicants respectfully request that the rejection be withdrawn.

In addition, neither Zeitman, Yoshida or Walker et al., alone or in combination, disclose or suggest “wherein the auctioning allows for at least one offer and at least one counteroffer”. Since there is not auction disclosed or suggested in any of the cited references, there can be no auction that allows for an offer and a counteroffer. Walker et al. discloses that there may be an offer and a counteroffer, but this is not in the context of an auction. See Col. 9, lines 45-51. For at least the additional reason that neither Zeitman, Yoshida nor Walker et al., alone or in combination, disclose or suggest the auctioning allowing for at least one offer and at least one counteroffer, Applicants respectfully request that the rejection be withdrawn.

Claims 15 and 22 stand rejected under 35 U.S.C 103(a) as being unpatentable over Zeitman, Yoshida and Walker and further in view of Sehr (U.S. Patent No. 6,085,976).

Sehr purports to disclose a travel system and methods that encompass a plurality of service providers and multi-application passenger cards so as to automatically compile, issue, utilize, and process the portable passenger cards for traveling purposes, purchase of travel-related goods and services. The multi-application cards are realized by smart debit and/or credit card technology and have the ability to store and activate a traveler's permit for transportation and other travel services. Biometrics identification of cardholders, as well as cryptographic certification of card data and travel-related information, can optionally be encoded onto the cards and can be verified, including validated, at various point-of-service locations upon presentation of the card. See Abstract.

Neither Yoshida, Zeitman, Walker et al. nor Sehr, alone or in combination, disclose or suggest at least “auctioning the good or the service” to the customer. Moreover, neither Zeitman, Yoshida, Walker et al. nor Sehr, alone or in combination, disclose or suggest the auctioning allowing for at least one offer and at least one counteroffer. Therefore, for at least these reasons, Applicants respectfully request that the rejection to claims 15 and 22 be withdrawn.

Claims 43 and 59-63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zeitman, Yoshida and Walker et al. in view of DeLorme et al. (U.S. Patent No. 5,948,040). Applicants respectfully traverse.


DeLorme et al. purports to disclose a computerized travel reservation information and planning system that generates "map ticket" output in various media, for guidance and transactions en route. Such print or electronic documents can include bar or alphanumeric codes for automated recognition and/or access. Menus enable flexible user inquiries accessing selectable geographic, topical, temporal and transactional data records and relational processing. Sub-menus provide further capabilities: e.g. routing, topical searching; searches of events calendars, almanacs, appointment books, related itinerary scheduling; trip budgeting issues, plus travel arrangement availabilities or other goods/services offers. Online communications links access updated or supplemental information on places, times, topics and other provider goods/service offers. See Abstract.

Neither Yoshida, Zeitman, Walker et al., or Delorme et al., alone or in combination, disclose or suggest at least "auctioning the good or the service" to the customer. Moreover, neither Zeitman, Yoshida, Walker et al. nor Delorme et al., alone or in combination, disclose or suggest the auctioning allowing for at least one offer and at least one counteroffer. For at least this reason, Applicants respectfully request that the rejection to claims 43 and 59-63 be withdrawn.

Claims 67-68 stand rejected under 35 U.S. C. 103(a) as being unpatentable over Zeitman, Yoshida, and Walker et al. in view of DeLorme. As discussed above, neither Zeitman, Yoshida, Walker et al. nor DeLorme, alone or in combination, disclose or suggest at least the feature of the independent claims of auctioning the good or the service to the customer, wherein the auctioning allows for at least one offer and at least one counteroffer. Thus, for at least these reasons, Applicants respectfully request that the rejection to claims 66-68 be withdrawn.

For all of the above reasons, Applicant respectfully requests reconsideration and allowance of the present application. The Examiner is invited to contact the undersigned attorney at (312) 321-4224 if there are any outstanding issues that could be resolved through a telephone conference.

Respectfully submitted,



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